

Attorney Docket No. 5725-8362-00  
Customer No. 222552

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

**Isabelle BARA et al.**

Serial No.: 09/277,226

Filed: March 26, 1999

For: W/O EMULSION, COMPOSITION  
COMPRISING SUCH AN EMULSION  
AND COSMETIC, PHARMACEUTICAL  
OR HYGIENE USE THEREOF

Group Art Unit: 1619

Examiner: A. Berman

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**RESPONSE TO ELECTION OF SPECIES REQUIREMENT**

In the Office Action dated December 17, 2001, the Examiner has required Applicants to elect a single species from each of the following groups a, b, and c for prosecution on the merits:

- a. the dyes of claims 16-19 or 20-22,
- b. the silicone oils of claims 24 or 25-27, and
- c. the compositions of claims 30-33 or 30 and 34-37 or 30 and 38 or 30 and 67 or 39-40 or 41 or 42 or 43 or 44-45 or 48 or 49-57 or 58 or 60 or 63 or 64-65 or 66 or 67.

(Office Action dated December 17, 2001, pages 2-3.)

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Applicants understand this confusing list in (c) to mean that they must elect:

- (1) one species of additional silicone compound from claims 30-37, or
- (2) one species of additional silicone compound from claims 30-37 and one species of silicone resin from claim 38, or
- (3) one species of additional silicone compound from claims 30-37 and one species from any of claims 67, 39-45, 48, 49-58, 60, 63-67.

Applicants respectfully traverse this election of species requirement. To be fully responsive, however, Applicants, with traverse, elect the following species:

- group a: titanium dioxide or iron oxide (claim 16),
- group b: cyclohexadimethylsiloxane (claim 26), and
- group c: (option (3) above) the composition of claim 30 [silicone gums (claims 30-33)] and the composition of claim 50 [nylon powders (claims 50-54)].

Applicants traverse this requirement on the ground that it would not be unduly burdensome for the Examiner to conduct a search for all the claimed compositions, as it is likely that art encompassing each of the elected species would also encompass the other claimed species. Applicants do not make any statement regarding the obviousness of one species relative to any other, nor should one be inferred. Applicants merely assert that a search of all the claimed species would not be unduly burdensome.

Accordingly, Applicants respectfully request that all of the claimed species be examined in this application. If the Examiner chooses to maintain the election requirement, Applicants expect the Examiner, if the elected species are found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, and then to extend the search to

a reasonable number of the non-elected species, as is the Examiner's duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. In any case, the election of species requirement should be withdrawn in view of the foregoing remarks.

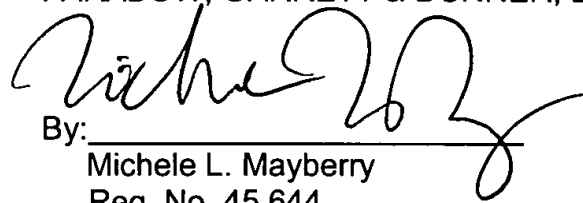
**Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of the election requirement and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON,  
FARABOW, GARRETT & DUNNER, L.L.P.

  
By: \_\_\_\_\_  
Michele L. Mayberry  
Reg. No. 45,644

Dated: January 17, 2002